



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---------------|-------------|-----------------------|---------------------|
| 09/441,142 | 11/12/99 | MURRAY | W 94111-3834 |

MICHAEL E. WOOD
MCCUTCHEN, DOYLE, BROWN & ENERSON, LLP
THREE EMBAREADERO CENTER
SUITE 2500
SAN FRANCISCO CA 94111-4067

PM82/0105

| EXAMINER | |
|------------|--------------|
| BOUCHER, D | |
| ART UNIT | PAPER NUMBER |
| 3627 | 15 |

DATE MAILED:

01/05/01

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

a) ☒ is extended to run _____ or continues to run 3 mo from the date of the final rejection

b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☐ Applicant's response to the final rejection, filed _____ has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☒ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

a) ☒ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.

b) ☒ They raise new issues that would require further consideration and/or search. (See Note).

c) ☐ They raise the issue of new matter. (See Note).

d) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

e) ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: Applicant's additional claim language to claims 56 & 61 are new issues requiring further consideration

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: _____

Claims objected to: _____

Claims rejected: 56-65; 71-82

However;

☐ Applicant's response has overcome the following rejection(s): _____

4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because _____

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

Darnell Boucher
DARNELL BOUCHER
PRIMARY EXAMINER

Art Unit: 3627

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 56, 59, 61, 64, 71, 74, 76, 77, 80, 82 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by German patent 3824393. With regard to claims 59, 64, 74 and 80 German patent teaches some measurable amount of rotation or swinging of the locking arm (5, Fig. 1). It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. See Board decision of August 19, 1998 which sustains the examiner's rejection under 35 U.S.C. 102(b) of claim 59 as anticipated by German Patent (Rimanek) in that case.

Claim 59 is reproduced below in italics with Examiner's reading of Rimanek marked off in parentheses. Appellants' claim has been given its broadest reasonable interpretation.

An apparatus (1) for connecting to a portable electronic device having an external wall provided with a specifically-designed generally rectangular security slot having preselected dimensions wherein said external wall has an inner surface, (functional recitation in the preamble of intended use not germane to the issue of patentability. See In re Casey, 370 F.2d 576; Rimanek teaches a specially designed slot having

Art Unit: 3627

preselected dimensions and an external wall and an inner surface) *comprising:*

a slot engagement member (5) having a first portion (lower section including slot engaging member 6) and a second portion, (upper section held in housing 3 and having an aperture for accepting a cable lock 17) said first portion including a slot engaging member (6) adapted for insertion within the security slot (2) when in a first position having said slot engaging member aligned with the security slot (as shown in figure 1, the engagement member 5 is aligned with slot 2 during the insertion step of the locking process) and adapted to engage an inner surface of the external wall to inhibit removal of the slot engaging member from the security slot when in a second position having said slot engaging member misaligned with the security slot (as shown in figure 2, the slot engaging member 6 is brought into contact with a lip of a notch in slot 2 which is misaligned from the longitudinal axis of the slot), said second portion defining a first aperture (accepts shackle 17) wherein said second portion extends out of the security slot when said slot engaging member is in said second position; and

a housing (3) having a second aperture (accepts shackle 17) and a receptacle (accepts engagement member 5; see figure 4), said receptacle adapted for mating to said second portion of said slot engagement member wherein said first aperture and said second aperture are aligned when said housing is mated to said second portion and slot engaging member is in said second position (see Figures 2 and 4) , said housing including a pin (4) that extends into the slot when said housing is mated to said slot engagement member and said apertures are aligned, wherein said pin inhibits said slot engaging member from returning to said first position (pin 4 is received in the longitudinal extending slot 2 where it prevents removal of the slot engaging member 6 from the slot 2) and thereby inhibits removal of said slot engaging member from the security slot.

Art Unit: 3627

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 56-65 and 71-82 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sloop, Sr. 4,704,881. Sloop, Sr. teaches all the elements of the claimed invention including housing 66, moveable locking arm 62 with locking member 64, pin 76, and cable (shackle of padlock) for attachment to an object other than to the portable object (the body of the padlock 24 or the locking device itself). Sloop, Jr. teaches use of his barrel lock assembly with a conventional padlock. It is inherent in the prior art disclosure of Sloop, Jr. that any conventional padlocks including those that have a flexible cable shackle are useable. In the alternative, the Examiner takes OFFICIAL NOTICE that padlocks having flexible cable shackles are well known. See Foote 3,765,197. It would have been obvious to one of ordinary skill in the art to use any conventional padlock including those that have a flexible cable shackle with the Sloop, Jr. barrel lock assembly. The curved contour of abutment 64 is considered to fit together/match/respond to a curved periphery of the apertures 44,42. The lock housing of Sloop, Sr. is a portable object which is prevented from being removed when in the locked position. Sloop, Sr. also teaches locking member 64 being maneuvered with slight angular

Art Unit: 3627

or rotative movements until it engages the wall of the lock retaining means 38. See column 3, lines 38-43. It has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

6. Claims 56-65 and 71-82 are provisionally rejected under the judicially created doctrine of double patenting over any claims of any copending Applications which claim the same subject matters set forth in the claims of this application and claim the benefit of earlier filing date under 35 USC 120 over all applications listed on page 1 of applicant's disclosure and any other copending cases not listed which claim the benefit of earlier filing under 35 USC 120 of any applications listed on page 1 of applicant's disclosure. Because applicants are in a better position to know what applications are pending at the time of response to this office action and what is being claimed in those applications, applicants' shall provide such information for the which the

Art Unit: 3627

Examiner will verify if the application is in condition for allowance. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a locking device with a locking member which locks down a piece of portable equipment having an aperture corresponding to the locking member with a cable.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804. Although restrictions and election of species have been made in several of applicants' copending applications, at least claim 56 of the current case is generic to several embodiments.

7. Claims 56-65 and 71-82 are rejected under the judicially created doctrine of double patenting over any claims of any U. S. Patents granted to applicants' which claim the same subject matter set forth in the claims of this application and claim the benefit of earlier filing date under 35 USC 120 over all applications which matured into patents listed on page 1 of applicant's disclosure and any other copending applications which have matured into patents not listed which claim the benefit of earlier filing under 35 USC 120 of any applications listed on page 1 of applicant's disclosure, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. Because applicants are in a better position to know what

Art Unit: 3627

applications have matured into patents at the time of response to this office action and what is being claimed in those patents, applicants' shall provide such information for the which the Examiner will verify if this application is in condition for allowance.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804. Although restrictions and election of species have been made in several of applicants' copending applications, at least claim 56 of the current case is generic to the several embodiments and the Examiner knows of at least U.S. Patent number 5,502,989 which claims the same invention elected in this application.

Applicants are invited to contact the Examiner, if they fail to understand the double patenting rejections being made and what they are required to provide on the terminal disclaimer in order to overcome these rejections.

Response to Arguments

8. Applicant's arguments filed July 3, 2000 have been fully considered but they are not persuasive. The addition of the portable device being electrical has not be given patentable weight since this limitation is to the intended use of the locking device system and the slot within which it is designed to be used has no bearing on the structure of the locking device system. Applicants have indicated that appropriate terminal disclaimers will be filed upon issuance of the

Art Unit: 3627

case, however, in order for response to this action to be responsive, applicants must provide a listing of pending applications and allowed patents so that the examiner may review such applications and patents for double patenting. If this application results in an appeal, applicants should indicate in any appeal that they do not intend a double patenting rejection to specific applications or patents to be a new ground of rejection since they are aware of their responsibility to provide the appropriate listing of pending applications and patents to the examiner.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3627

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darnell Boucher whose telephone number is (703) 308-2492.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BethAnne Dayoan, can be reached at (703) 308-3865.

Submission of your response by facsimile transmission is encouraged. Group 3620's facsimile number is (703) 305-3597. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP § 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP § 512). The following is an example of the format the certification might take:

Art Unit: 3627

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-3597) on _____ (Date)

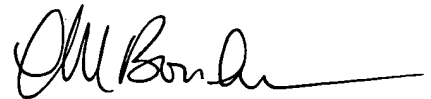
(Typed or printed name of person signing this certificate)

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CAR 1.4 and MPEP § 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry of a general nature relating to the status of this application should be directed to the group receptionist at (703) 308-2168.

September 24, 2000


DARNELL BOUCHER
PRIMARY EXAMINER